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EXAMINER

LIN, SHEW FEN

ART UNIT PAPER NUMBER

2166

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/600,014

Applicant(s)

CHATTERJEE ET AL.

Examiner

Shew-Fen Lin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 12-24, and 12-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 12-24, 25-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/6/2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- a. This action is taken to response to amendments and remarks filed on 7/6/2006.
- b. Claims 1-4, 12-24, and 26-28 are pending and claims 5-11 and 25 have been cancelled. Claims 1, 12, 18, and 21 are independent claims.

Specification

In view of the amendment to the specification, the Examiner withdraws the pending objection to the specification.

Drawings

In view of the amendment to the drawings, the Examiner withdraws the pending objection to the drawings.

Response to Amendment and Remarks

Applicant's remarks submitted on July 6, 2006 with respect to claims 1-24 have been fully reconsidered but are not deemed persuasive for the reasons set forth below.

Response to remarks on claim rejections – Double Patenting

Regarding Applicant's arguments for claims 12 and 18 that "the claims in the current application are not 'later patent claims'", and thus cannot be rejected under the judicially created doctrine of obviousness-type double patenting.

The Examiner recognizes "The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to

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prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees.” See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

For the reasons above, the Examiner believes the rejection given in last office action is proper and the Examiner’s stance regarding the status of double patent rejection for claims 12 and 18 remains the same as stated in the previous Office Action.

Regarding Applicant’s arguments for claim 21, in view of the amendment to claim 21, the Examiner withdraws the double patent rejection.

Response to remarks on claim rejections (12-24)

Applicant contends that Gupta et al. (US Patent 6,956,593 hereinafter referred as Gupta) do not teach the limitation of “selecting, based, at least in part, on the set of identifying parameters, an annotation structure defining one or more annotation fields” because there is no teaching of the selection, by an application, of “an annotation structure defining one or more annotation fields”. The Examiner respectfully disagrees with this assessment for the following reason.

First, Gupta discloses annotations based on a set of parameters, where the parameters correspond to a temporal range of the media content as defined by a beginning point and ending point (column 2, lines 23-27).

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Second, Gupta discloses the selection of an annotation structure defining one or more fields (Figure 7, column 13, lines 25-32) based on the temporal location identified by the beginning/ending points (“the identifying parameters”, column 11, lines 45-51).

Therefore, the Examiner’s stance regarding the status of claims 12 and 18, and all those claims depending on it, remains the same as stated in the previous Office Action.

Response to remarks on claim rejections (1, 21)

Applicant's arguments with respect to claims 1 and 21 have been considered but are moot in view of new/old grounds of rejection. Upon further search the Examiner has found the prior art reference of Electrical Schematics Page, in combining with Altman. Refer to the corresponding sections of the claim analysis for detail.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12 and 21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over **Co-pending Application No(s). 10/600,021**. The mapping of the similar claims is as following:

<i>Claims Comparison Table</i>	
Instant Application 10/600,014	Patent Application 10/600,021
12	15
18	25

Although the conflicting claim is not identical, they are not patentably distinct from each other because they are substantially similar in scope and they use the same limitations.

Claims 15, 25 of the **10/600,021** recite additional limitation “**from a set of annotation structures..**”, it would have been obvious to a person of ordinary skill in the art at the time of invention was made to include or omit this limitation and still perform the same functions as before. Because, in order to “selecting,...an annotation structure”, it would be obvious that the selection must be made “from a set of annotation structures”.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 12-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Gupta et al.

(US Patent 6,956,593, hereinafter referred as Gupta).

As to claim 12, Gupta discloses a method of creating annotations for a plurality of different type data objects (column 1, lines 33-34) manipulated by a plurality of applications, comprising:

receiving a request from one of the applications to create an annotation for a data object identified by a set of parameters (Figures 5-7, column 11, lines 36-44, column 12, lines 47-50);

selecting, based, at least in part, on the set of identifying parameters (column 11, lines 45-51), an annotation structure defining one or more annotation fields (select different annotation structure, text, audio, or URL, Figure 7, column 13, lines 25-32);

generating a graphical user interface allowing entry of the one or more annotation fields (Figures 8-10, column 14, lines 58-65, column 15, lines 10-33);

creating an index based on the one or more identifying parameters (unique annotation identifier, Figure 4, item 194, column 9, lines 1-2); and

creating an annotation record comprising the index and information entered, via the graphical user interface, for the one or more annotation fields (add annotation record through GUI, Figures 8-10, column 12, lines 56-59, column 14, lines 40-48).

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As to claim 13, Gupta discloses further comprising storing the annotation record in an annotation store separate from the annotated data object (store in annotation meta store, Figures 1 and 3, column 7, lines 28-39).

As to claim 14, Gupta discloses wherein selecting the annotation structure comprises:
presenting, to a user, a plurality of annotation structures associated with the data object (Figure 7, column 13, lines 25-28); and
receiving, from the user, a selection of one of the plurality of annotation structures (column 15, lines 13-24).

As to claim 15, Gupta discloses further comprising receiving, from the user, a selected role in which the user has chosen to act (selection of annotation set to act, column 12, lines 65-67, column 13, lines 1-5).

As to claim 16, Gupta discloses wherein the plurality of annotation structures presented to the user is dependent on the selected role (annotation server supports access control, column 13, lines 1-5, column 16, lines 1-6).

As to claim 17, Gupta discloses further comprising generating a graphical user interface for displaying the annotation information, wherein the annotation information presented to the user in the graphical user interface is dependent on the selected role (column 16, lines 1-6).

As to claim 18, Gupta discloses a computer-readable medium containing an executable component for managing annotations created for data objects manipulated by one or more applications on a network which, when executed by a processor, performs operations comprising:

receiving a request from one of the applications to create an annotation for a data object (Figures 6-7, column 12, lines 47-50);

selecting, based, at least in part, on a set of parameters identifying the data object (Figure 5, column 11, lines 36-44) or the application, an annotation structure defining one or more annotation fields (select different annotation structure, text, audio, or URL, Figure 7, column 13, lines 25-32);

generating a graphical user interface screen allowing entry of the one or more annotation fields described by the structure (Figures 8-10, column 14, lines 58-65, column 15, lines 10-33);
and

storing an annotation record comprising information entered, via the graphical user interface screen, for the one or more annotation fields in an annotation store separate from the annotated data object (add annotation record through GUI, Figures 8-10, column 12, lines 56-59, column 14, lines 40-48, store in annotation meta store, Figures 1 and 3, column 7, lines 28-39).

As to claim 19, Gupta discloses wherein receiving a request from one of the applications to create an annotation for a data object comprises receiving the request from a plug-in annotation component (interface module could be a plug-in to an application, column 12, lines 3-13).

As to claim 20, Gupta discloses wherein selection of the annotation structure is based, at least in part, on one or more user credentials (based on access control, column 16, lines 1-6).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4, 21-24, and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Altman (US Pub 2004/0163042) in view of ESP (Electrical Schematics Page, April 25, 2002, http://www.jlab.org/accel/inj_group/elec1.htm).

As to claim 1, Altman discloses a method for exchanging information between entities on a network comprising:

installing an annotation management system on the network (paragraph [0038], lines 3-5, paragraph [0041], lines 17-19);

identifying a plurality of annotatable data objects (documents to be annotated, paragraph [0003]) manipulated by a plurality of applications on the network (web browser, lotus note, acrobat, Figure 5, paragraph [0041]), wherein the plurality of annotatable data objects comprise at least one of electrical schematics and mechanical schematics; and

providing, via the annotation management system (annotation plug-in, paragraph [0041], lines 6-11), one or more interfaces for manipulating annotations for the annotatable data objects (create/modify through GUI, Figures 4A-C, paragraph [0040], 3-6, paragraph [0041], lines 6-11, paragraph [0043], lines 11-14).

Altman discloses that annotatable data objects can be a blueprint for architect or professional engineer (paragraph [0048]) does not explicitly disclose wherein the plurality of annotatable data objects comprise at least one of electrical schematics and mechanical schematics.

ESP discloses annotatable data objects of electrical schematics in an Acrobat PDF format (page 1).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to combine Altman and ESP teaching to annotate electrical schematics such that workflow message can be generated and reviewed (Abstract, Altman). The skilled artisan would

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have been motivated to improve the invention of Altman per the above by adding annotation on a electrical schematics diagram.

As to claim 2, Altman discloses wherein providing one or more interfaces comprises providing at least one interface for creating annotations (Figures 9A, 9B, paragraph [0054]) and at least one interface for viewing annotations (paragraph [0047]).

As to claim 3, Altman discloses wherein the one or more interfaces comprise at least one graphical user interface (Figure 9B, paragraph [0047]).

As to claim 4, Altman discloses wherein the at least one graphical user interface is accessible from within one or more of the applications (web browser, paragraph [0041], lines - 11).

As to claim 21, Altman discloses a system for managing annotations for one or more different type data sources manipulated by a plurality of different type applications, comprising:

an annotation database for storing annotations separately from the data sources associated with the annotations (Abstract, Figures 3B, 4A, 4B, 4C, paragraph [0040], lines 3-6), wherein the one or more different type data sources comprise at least one of electrical schematics and mechanical schematics;

a set of annotatable data object points defining portions of the data sources associated with the annotations described by the associated annotations (Figure 6, paragraph [0042]);

a set of annotation structures, each defining a set of annotation fields (Figure 13A, paragraph [0043]);

a set of plug-in components, each for interfacing between one or more applications and an annotation server (paragraph [0041]); and

an annotation server (annotation repository, abstract) configured to receive, via the plug-in components (annotation manager, paragraph [0041], lines 13-16), requests to access annotations for one or more of the annotatable data object points issued by the one or more of the applications running on the client computer (paragraph [0047]) and generate a graphical user interface screen, based on an annotation structure associated with the one or more of the annotatable data object points, for creating or viewing annotations for the one or more annotatable data object points (Figures 8A, 9A, paragraph [0051], [0054]).

Altman discloses that annotatable data objects can be a blueprint for architect or professional engineer (paragraph [0048]) does not explicitly disclose wherein the one or more different type data sources comprise at least one of electrical schematics and mechanical schematics.

ESP discloses annotatable data source of electrical schematics in an Acrobat PDF format (page 1).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to combine Altman and ESP teaching to annotate electrical schematics such that workflow message can be generated and reviewed (Abstract, Altman). The skilled artisan would have been motivated to improve the invention of Altman per the above by adding annotation on a electrical schematics diagram.

As to claim 22, Altman discloses wherein the one or more different type data sources comprise at least text documents and database tables (paragraph [0009]).

As to claim 23, Altman discloses wherein the annotatable data object points comprise at least one or more database cells, and one or more portions of text documents (Figure 6, paragraph [0042]).

As to claim 24, Altman discloses wherein the one or more different type data sources further comprise at least multimedia files (combination of images and text, paragraph [0003], line 4) and the annotatable data object points comprise at least an image (paragraph [0043], lines 1-7).

As to claim 26, Altman discloses wherein the annotation server is configured to create annotations with no direct association to any of the annotatable data object points (paragraph [0043], lines 7-14).

As to claim 27, Altman discloses wherein the annotation server is configured to create annotations associated with more than one of the data sources (scanned image, computer generated files, database, paragraph [0009]).

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As to claim 28, Altman discloses wherein the annotation server is configured to create more than one annotation for a single annotatable data point (multiple reviews, Figure 8A, paragraph [0051]).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shew-Fen Lin whose telephone number is 571-272-2672. The examiner can normally be reached on 8:30AM - 5:00PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a

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general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Shew-Fen Lin
Patent Examiner

Art Unit 2166
October 13, 2006


MOHAMMAD ALI
PRIMARY EXAMINER